

REMARKS / ARGUMENTS

Claims 31-33, 35-37 and 44-55 remain pending in this application. No claims have been canceled or added.

Double Patenting Rejection

Claims 31-33, 35-37 and 44-55 stand rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 6,868,398. Without admitting to the propriety of the rejection, Applicants submit herewith a terminal disclaimer to avoid the rejection.

35 U.S.C. §103

Claims 31-33, 35-37 and 44-55 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Crawford (U.S. Patent No. 6,411,943) and further in view of Shear (U.S. Patent No. 4,827,508). These rejections are traversed as follows.

The present invention is directed to a method in which an owner of a storage system rent the same to a user. The storage system is held at the user's site as opposed to the owner's site. The storage system has a management table which stores information regarding a state of use of disk drives. The owner obtains information of the management table from the user's site.

According to independent claims 31 and 44, the use of an initial volume is charged at a predetermined rate and an additional volume is provided to the user as needed. A portion of the additional volume that is actually used by the user is

charged at a first rate and the remainder of the additional volume that is not actually used is charged at a second rate that is different from the first rate. According to dependent claims 32 and 45, for example, the charging for the additional volume occurs after a sixth period of time determined by a contract. Independent claim 50 doesn't recite an initial volume and an additional volume, but does recite charging differently depending upon a portion of the volume is actually used.

It is submitted that the above-mentioned features of the present invention are neither disclosed nor suggested by the cited references whether taken individually or in combination. In Fig. 1, Crawford discloses a customer computer 50 which connects to an on-line service system 100 which provides data storage for the customer computer 50. Therefore, Crawford does not disclose the renting of a storage system to a user such that the storage system is held at the user's site. Instead, Crawford discloses a system in which additional storage is held at the on-line service system (see column 14, lines 34-44). A data link 150 is provided so that the customer computer 50 can perform data I/O with the on-line service system 100.

On the other hand, in the present invention, no such data link is necessary. Since the storage system is held at the user's site, the user can directly access this storage without having to connect to the owner's site. Therefore, the providing of the storage system to the user to be held at the user's site and then charging for renting of such storage is clearly distinguishable from the disclosure of Crawford. Furthermore, Crawford actually teaches away from the present invention by stating that a user could upgrade the customer computer by adding additional internal or

external storages, but that this would be expensive and might not be cost effective (see column 13, lines 51-54). Therefore, not only does Crawford fail to disclose the renting of a storage system that is held at a user's site, Crawford teaches away from adding storage to a user's site and renting such storage as presently claimed.

The Examiner acknowledges that Crawford does not explicitly disclose that the storage system is held at a site of the user and that the owner obtains information of a management table from the user's site. The Examiner attempts to rely upon Shear for supplying this missing disclosure. However, it is submitted that Crawford and Shear cannot be combined in the manner asserted to arrive at the presently claimed invention.

First of all, the two references cannot be combined in the manner asserted since Crawford actually teaches away from providing additional storage at a user's site (see column 13, lines 51-54). Secondly, Shear discloses that a library of databases can be kept at a user's site for use as needed. For example, CD-ROM disks containing various publications could be sent to a user such that the user would be charged for actual use of certain publications and the publisher would be able to receive an appropriate "copyright royalty" (see column 4, lines 9-20).

Simply because Shear discloses sending prerecorded material on a medium such as an optical disk, a bubble memory or a large hard disk "prepared by the database owner and licensed to the user for use" to the user (see column 9, lines 32-36, emphasis added), one of ordinary skill in the art would not combine this teaching with Crawford in order to provide additional volumes of storage at a user's site.

Furthermore, the fact that Shear discloses a mechanism to charge the user for use of the data prepared by the database owner, one of ordinary skill in the art would not be motivated to completely change the purpose of storage system of Crawford to arrive at the presently claimed invention.

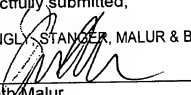
As mentioned above, Crawford teaches away from adding storage to a user's site. Shear discloses providing various types of information (databases, publication, etc.) to the user, as a library to be kept with the user, and charging for its use. Therefore, if these two references could be combined, one of ordinary skill in the art would, at best, use their teachings independently so as to provide a user with a remote storage (Crawford) and with a library of prerecorded material (Shear). One of ordinary skill in the art would not be motivated to combine these references to arrive at the presently claimed invention absent hindsight reconstruction. As such, it is submitted that the pending claims patentably define the present invention over the cited art.

Conclusion

In view of the foregoing, Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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